

**REMARKS**

Claims 1-49 are currently pending.

In the Office Action, the Examiner requires that the claims be restricted to one of the following two groups under PCT Rule 13.1:

- I. Claims 1-34, drawn to a method, and
- II. Claims 35-49, drawn to a composition.

See Office Action at 2.

Applicants respectfully traverse the restriction requirement. However, to be fully responsive, Applicants elect the subject matter of Group I, comprising claims 1-34.

The Examiner alleges that Groups I and II do not relate to a single general inventive concept because "The single general inventive concept, a coating composition including magnesium powder and binder, is known in the art as evidenced by the International Search Report and Written Opinion in PCT/US04/33089. Consequently, unity is lacking *a posteriori*." *Id.* at 2.

In response, Applicants submit that the Examiner has not established a proper basis for the Restriction Requirement. Applicants respectfully refer the Examiner to M.P.E.P. § 803, which sets forth the criteria and guidelines for Examiners to follow in making proper requirements for restriction. The M.P.E.P. instructs the Examiner as follows:

If the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions.

M.P.E.P. § 803 (emphasis added).

Here, the Examiner has not shown that examining Groups I and II together would constitute a serious burden, irrespective of whether or not they relate to a single general inventive concept. The Examiner does not specify what serious burden will be placed on the Examiner if the Examiner were to proceed in examining Groups I and II together, as required by M.P.E.P. § 803. In particular, Applicants note that all of the pending claims at least relate to a metal coating which comprises magnesium powder and a binder, and improves the metal's corrosion resistance. Thus, all of the claims comprise a single general inventive feature.

Additionally, Applicants submit that no serious burden would exist in light of the requirement of rejoinder. *See* M.P.E.P. § 821.04. Indeed, the Examiner states that should "the product claims [be] subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitation of the allowable product claim will be considered for rejoinder." Thus, it is unclear what burden is on the Examiner to examine the claims of Groups I and II together, and Applicants respectfully request withdrawal of the restriction requirement.

The Examiner has further required an election of species. Amended claim 1 now recites a method of treating an aluminum or an aluminum alloy metal to improve the metal's corrosion resistance, said method comprising: applying, to the surface of the metal, a coating which comprises magnesium powder and a binder. The Examiner has not identified a particular genus from which a species is to be elected. Applicants understand this election of species requirement to relate to the binder in the coating

composition.<sup>1</sup> Applicants, with traverse, elect a binder having a polyisocyanate, 1,6-hexamethylene diisocyanate homopolymer (HMDI) and an epoxy-based resin, which is a polyglycidyl derivative of a phenolic resin. A coating composition with this binder is described in Example 7 where Desmodur 3300 is the polyisocyanate and EPON 1001 is the epoxy base resin. Claims 1-3, 5-19, and 21-34 read on the elected species.

If the Examiner believes a telephone conference could be useful in resolving any outstanding issues, the Examiner is respectfully invited to contact Applicants' undersigned counsel at (703) 776-9705.

Respectfully submitted,

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<sup>1</sup> If this not the case, Applicants request further clarification of the election of species requirement and will supplement their election. If no election of species was intended, Applicants respectfully request the Examiner consider the full scope of the elected claims.